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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,938	08/18/2003	Stephen M. Foster	47099-00011USC1	4297
28763	7590	05/31/2005		EXAMINER
WINSTON & STRAWN LLP 1700 K STREET, N.W. WASHINGTON, DC 20006			SLACK, NAOKO N	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,938	FOSTER, STEPHEN M.	
	Examiner Naoko Slack	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 August 2003.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 47-87 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 47-87 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 8/18/03 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/28/03.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Preliminary Amendment***

As requested by preliminary amendment received August 18, 2003, the specification and claims have been amended. Claims 1-46 have been canceled, and new claims 47-87 have been entered and examined.

***Information Disclosure Statement***

Applicant's information disclosure statement received October 28, 2003 has been entered. However, the information disclosure statement fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Specifically, German Patent DE 6605008 lacks a statement of relevance and has been crossed from the list. All other references have been considered.

***Specification***

The disclosure is objected to because of the following informalities:

On page 19, line 20, "23" should be -- 21 --.

Appropriate correction is required.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 47-87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 17, 25, and 29 of U.S. Patent No. 6,607,803 to Foster. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claims 47, 48, 63, 68-72:

Though claims 1, 9, 17, 25, and 29 of Foster '803 do not specify that the laminated film foam is placed over a subflooring, it would have been obvious to one of ordinary skill in the art to place the film foam atop the subflooring, as the film foam composition is placed adjacent the wood finish floor, which is the topmost layer of the flooring, and therefore, the other side of the film foam composition would contact the subflooring. A concrete subflooring such as concrete slab is well known in the art.

Claims 49, 50, 79-82:

While claims 1, 9, 17, 25 and 29 do not specify whether the film sheet is

contacting the subflooring or the laminate wood flooring as stated in applicant's claims, both variations are claimed by applicant. Therefore, the orientation does not appear to be critical, and it would have been obvious to one of ordinary skill in the art to position the film sheet in either of the stated orientations.

Claims 66 and 67:

Claims 66 and 67 are drawn to a method of laminating the film sheet to the foam sheet. The method of forming a laminated product does not further limit the method of installation of a wood floor. Therefore, without further limitations to the method of installation, the claims are met by Foster '803.

Claim 54 corresponds to claim 18 of Foster '803.

Claim 55 is within the range 1-10 mils stated in claim 17 of Foster '803.

Claim 56 corresponds to claim 19 of Foster '803.

Claim 57 corresponds to claim 20 of Foster '803.

Claim 58 corresponds to claim 21 of Foster '803.

Claim 59 corresponds to claim 22 of Foster '803.

Claim 60 corresponds to claim 23 of Foster '803.

Claim 61 corresponds to claim 24 of Foster '803.

Claim 62 corresponds to claim 24 of Foster '803.

Claims 64 and 65 correspond to claim 2 of Foster '803.

Claims 73-76 correspond to claims 9 and 25 of Foster '803.

Claims 77 and 78 correspond to claim 25 of Foster '803.

Claim 51-53 and 83-87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,607,803 to Foster in view of US Patent 5,617,687 to Bussey, Jr. et al.

While claim 17 of Foster '803 does not specify that the film foam composition is provided in roll form, Bussey, Jr. et al. discloses a film-foam composition for flooring that is supplied in roll form and illustrates that application of the roll to the building by overlapping one edge of the film sheet (column 4, lines 56-58). In view of Bussey, Jr. et al. it would have been obvious to one of ordinary skill in the art to supply the film foam composition in roll form and apply the sections in overlapping format to provide a tight seal.

While Foster '803 does not specify that the subflooring is a concrete subflooring, a preexisting flooring, a preexisting flooring over a concrete subflooring, or a preexisting floor of ceramic tile or linoleum, the stated types of subflooring are well known in the art. It would have been obvious to one of ordinary skill in the art to apply the installation method to subfloor materials commonly used, such as concrete, tile, or linoleum.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose telephone number is (571) 272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack  
Primary Examiner  
Art Unit 3635

NS  
May 20, 2005